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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

SHEDRICK, CHARLES TERRELL

ART UNIT PAPER NUMBER

2687

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/751,485

Applicant(s)

SATO, TATSUHIRO

Examiner

Charles Shedrick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 15** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

**Claim 15**, claims the non-statutory subject matter of a program. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed programs are not tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-7,9,11,12, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Takahiro JPO Patent Publication #11282863 A** in view of **Hiroshi et al. JPO Patent Publication # 06334703 A**.

Consider **claim 1, Takahiro** clearly disclose an apparatus **10 (figure 1)** which acquires position information about a user of plural types of information terminals (i.e., notebook, desktop, or mobile user terminal) different in position information communication system (**paragraph 0013**), comprising; and a position information extraction unit **15,16 (figure 1)** (i.e. user interface units) extracting position information about a user from the data transmitted from the information terminal in response to the determination result (**paragraph 0014**).

However, **Takahiro** does not clearly disclose a terminal determination unit determining a type of the information terminal depending on data transmitted from an information terminal of the user.

In the same field of endeavor, **Hiroshi et al.** clearly discloses a terminal determination unit **15 (figure 2)** determining a type of the information terminal depending on data transmitted from an information terminal of the user (**paragraph 0009**).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Takahiro to include a terminal determination unit as taught by Hiroshi et al. for the purpose of customizing the invention to take full advantage of improvements.

Consider **claim 2** and **as applied to claim 1 above**, **Takahiro** as modified by **Hiroshi et al.** clearly disclose the apparatus further comprising an accounting unit **18 (figure 1)** performing an accounting process depending on an entry of a user in a system including the information terminal user position information acquisition apparatus (**paragraph 0017**).

Consider **claim 3** and **as applied to claim 1 above**. **Takahiro** clearly discloses the claimed invention except for the terminal determination unit.

However, in the same field of endeavor **Hiroshi et al.** clearly disclose the said terminal determination unit **15 (figure 2)** can determine a type of the information terminal depending on the data transmitted from an information terminal (**paragraph 0009**).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Takahiro to include a terminal determination unit as taught by Hiroshi et al. for the purpose of customizing the invention to take full advantage of improvements.

Consider **claim 4** and **as applied to claim 3 above**. **Takahiro** clearly discloses an apparatus further comprising a communications system and/or data conversion unit **15 (figure 1)** (i.e., the first gateway) converting data transmitted from an information terminal in a system of regularly or irregularly announcing position information when a service is not requested to an external device into the same communications system and/or data format as the data from the

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information terminal in the system of announcing position information when the service is requested to the external device in plural types (i.e., notebook, desktop, or mobile user terminal) of information terminals, of regularly or irregularly announcing position information when a service is not requested to an external device (**paragraph 0014,0021**).

However, **Takahiro** does not clearly disclose a terminal determination unit determining a type of the information terminal depending on data transmitted from an information terminal of the user.

In the same field of endeavor, **Hiroshi et al.** clearly discloses a terminal determination unit **15 (figure 2)** determining a type of the information terminal depending on data transmitted from an information terminal of the user (**paragraph 0009**).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Takahiro to include a terminal determination unit as taught by Hiroshi et al. for the purpose of customizing the invention to take full advantage of improvements.

Consider **claim 5** and **as applied to claim 4 above**, **Takahiro** as modified by **Hiroshi et al.** clearly disclose apparatus further comprising: a user authentication unit **19 (figure 1)** authenticating a user of a terminal which has announced position information using data from an information terminal of a system of announcing position information when a request is issued to an external device (**paragraph 0014, 0016, 0018**), or data converted by the communications system and/or data conversion unit **15 (figure 1)** (i.e., the first gateway) (**paragraph 0014**); and a position information storage unit **17 and 18 (figure 1)** storing position information extracted by a position information extraction unit together with information about the terminal determined by

said terminal determination unit (**paragraph 0016**).

Consider **claim 6** and as applied to **claim 5** above, **Takahiro** as modified by **Hiroshi et al.** clearly disclose apparatus further comprising an application linking apparatus **11,12,13 (figure 1)** for link with an application of a service provider for providing a service for a user (**paragraph 0013 0014**), wherein said application linking apparatus can further comprise a position information retrieval unit **15, 16 (figure 1)** for retrieving position information about specified user by said position information storage unit **17 and 18 (figure 1)**, and notifying the application side of the information (**paragraphs 0014-0016**) .

Consider **claim 7** and as applied to **claim 5** above, **Takahiro** as modified by **Hiroshi et al.** clearly disclose the apparatus wherein each time position information is announced from an information terminal of a user, said terminal determination unit can determine the type (i.e., notebook, desktop, or mobile user terminal) of information terminal, said position information extraction unit **15,16 (figure 1)** (i.e. user interface units) can extract position information (**paragraphs 0014,0015**), and said position information storage unit **17, 18 (figure 1)** can store latest position information and terminal information (**paragraph 0016**).

Consider **claim 9** and as applied to **claim 1** above, **Takahiro** as modified by **Hiroshi et al.** clearly disclose apparatus further comprising an application linking apparatus **11,12,13 (figure 1)** for link with an application of a service provider for providing a service for a user (**paragraph 0013, 0014**).

Consider **claim 11** and as applied to **claim 9** above, **Takahiro** as modified by **Hiroshi et al.** clearly disclose an apparatus comprising a position information reformat unit **15 (figure 1)** for receiving a request from a service provider, and reformatting position information about a

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user extracted by the position information extraction unit (**paragraph 0014**).

Consider **claim 12** and as applied to **claim 9** above, **Takahiro** as modified by **Hiroshi et al.** clearly disclose an apparatus comprising an accounting unit **18 (figure 1)** for performing an accounting process for a service provider a service provider on the communications established between a service provider and a user by a link with an application (**paragraph 0017**).

Consider **claim 18** **Takahiro** clearly discloses a apparatus **10 (figure 1)** which acquires position information about a user of plural types of information terminals (i.e., notebook, desktop, or mobile user terminal) different in position information communication system, comprising: a position information extraction means **15,16 (figure 1)** (i.e. user interface units) for extracting position information about a user from the data transmitted from the information terminal in response to the determination result (**paragraphs 0013-0016**)

However, **Takahiro** does not clearly disclose a terminal determination unit determining a type of the information terminal depending on data transmitted from an information terminal of the user.

In the same field of endeavor, **Hiroshi et al.** clearly discloses a terminal determination unit **15 (figure 2)** determining a type of the information terminal depending on data transmitted from an information terminal of the user (**paragraph 0009**).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of **Takahiro** to include a terminal determination unit as taught by **Hiroshi et al.** for the purpose of customizing the invention to take full advantage of improvements.



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**Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Takahiro JPO Patent Publication #11282863 A** in view of **Hiroshi et al. JPO Patent Publication # 06334703 A** and further in view of **Jacobson et al U.S. Patent # 6,466,796, B1**.

Consider **claim 8** and as applied to **claim 3** above, **Takahiro** clearly disclose the apparatus further comprising: a user authentication unit **19 (figure 1)** authenticating a user of a terminal which has announced position information (**paragraph 0014,0016, 0018**); and a position information storage unit **17, 18 (figure 1)** storing position information extracted by said position information extraction unit **15,16 (figure 1)** (i.e. user interface units) together with information corresponding to an authenticated user (**paragraphs 0014-0016,0018,0019**), wherein when position information is simultaneously announced from a plurality of information terminals of the user said position information storage unit **17, 18 (figure 1)** can store position information from an information terminal (**paragraph 0016**).

However, **Takahiro** does not clearly disclose a terminal determination unit determining a type of the information terminal depending on data transmitted from an information terminal of the user.

In the same field of endeavor, **Hiroshi et al.** clearly discloses a terminal determination unit **15 (figure 2)** determining a type of the information terminal depending on data transmitted from an information terminal of the user (**paragraph 0009**).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of **Takahiro** to include a terminal determination unit as taught by **Hiroshi et al.** for the purpose of customizing the invention to take full advantage of improvements.

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Takahiro as modified by Hiroshi et al. clearly discloses the claimed invention except for a policy of prioritizing position information from which information terminal is set as a system operation environment; and prioritized by the policy.

In the same field of endeavor, Jacobson et al. clearly disclose a policy of prioritizing position information from which information terminal is set as a system operation environment; and prioritized by the policy (**abstract, figure 9, column 6 line 57 – column 7 line 22**)

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Takahiro to include the terminal determination unit as taught by Hiroshi et al. and further modify the invention to include a priority policy as taught by Jacobson et al. for the purpose of improving data quality and quantity.

**Claims 10,13, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Takahiro JPO Patent Publication #11282863 A** in view of **Hiroshi et al. JPO Patent Publication# 06334703 A** and further in view of **Toru JPO Patent Publication# 10162033**

Consider **claim 10** and **as applied to claim 9 above**, Takahiro as modified by **Hiroshi et al.** clearly disclose the claimed invention except an event notification unit for receiving designation of a condition.

However, in the same field of endeavor Toru clearly show and disclose an event notification unit for receiving designation of a condition (i.e., a technology is described for determining the present location, date, time, and place of a user and conducts an advising process only when the determined result matches a predetermined set of conditions) (**paragraphs 0006 – 0010**)

Therefore it would have been obvious at the time the invention was made to modify the apparatus of Takahiro as modified by Hiroshi et al. to include an event notification unit as taught by Toru to make the invention more efficient.

Consider **claim 13, Takahiro** clearly disclose a method for obtaining position information about a user of plural types of information terminals different in position (**paragraph 0013**):

However, **Takahiro** does not clearly disclose a terminal determination unit determining a type of the information terminal depending on data transmitted from an information terminal of the user.

In the same field of endeavor, **Hiroshi et al.** clearly discloses a terminal determination unit **15 (figure 2)** determining a type of the information terminal depending on data transmitted from an information terminal of the user (**paragraph 0009**).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Takahiro to include a terminal determination unit as taught by Hiroshi et al. for the purpose of customizing the invention to take full advantage of improvements.

**Takahiro** as modified by **Hiroshi et al.** clearly disclose the claimed invention. However **Takahiro** as modified by **Hiroshi et al.**, but does not disclose a notification system.

However, in the same field of endeavor Toru clearly show and disclose an event notification system (**Drawings 1 and 2**) for receiving designation of a condition (i.e., a technology is described for determining the present location, date, time, and place of a user and

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conducts an advising process only when the determined result matches a predetermined set of conditions) (**paragraphs 0006 –0010**).

Therefore it would have been obvious at the time the invention was made to modify the apparatus of Takahiro as modified by Hiroshi et al. to include an event notification unit as taught by Toru to make the invention more efficient.

Consider **claim 14, Takahiro** clearly disclose a computer-readable storage medium storing a program used to direct a computer forming an apparatus **10 (figure 1)** for obtaining position information about a user of plural types of information terminals different in position (**paragraph 0013**) comprising the steps of; extracting the position information about the user from the data transmitted.

However, **Takahiro** does not clearly disclose the step of determining a type of the information terminal depending on data transmitted from an information terminal of the user.

In the same field of endeavor, **Hiroshi et al.** clearly disclose the step of determining a type of the information terminal depending on data transmitted from an information terminal of the user (**paragraph 0009**).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the computer-readable storage medium storing a program used to direct a computer forming an apparatus of Takahiro to include the step of determining a type of the information terminal depending on data transmitted from an information terminal of the user as taught by Hiroshi et al. for the purpose of customizing the invention to take full advantage of improvements.

**Takahiro** as modified by **Hiroshi et al.** clearly disclose the claimed invention.

However **Takahiro** as modified by **Hiroshi et al.**, but does not disclose a notification system.

However, in the same field of endeavor Toru clearly show and disclose an event notification system for receiving designation of a condition (i.e., a technology is described for determining the present location, date, time, and place of a user and conducts an advising process only when the determined result matches a predetermined set of conditions) (**paragraphs 0006 – 0010**)

Therefore it would have been obvious at the time the invention was made to modify the apparatus of Takahiro as modified by Hiroshi et al. to include an event notification unit as taught by Toru to make the steps in the invention more efficient.

**Claims 16 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Takahiro JPO Patent Publication #11282863 A** in view of **Toru JPO Patent Publication# 10162033**

Consider **claim 16**, Takahiro clearly discloses a system **10 (figure 1)** of obtaining, managing, and using a status and a position of a user in an information terminal (**paragraph 0013**), comprising: a service synchronous position information acquisition unit **15 (figure 1)** for acquiring position information about an information terminal according to a first communications protocol which announces position information when a user requests a service (**paragraph 0015**); and a service asynchronous position information acquisition unit **20 (figure 1)** for converting various communications protocol depending on the information terminal into the first communications protocol when the user requests a service, and transmitting the position information to the service synchronous position information acquisition unit according to the converted first communications protocol (**paragraph 0014**), characterized in that said service synchronous position information acquisition unit comprises: a position information

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management unit **17 (figure 1)** for managing the status and position information acquired according to the first communications protocol for each user;

However, Takahiro does not clearly disclose an application link unit (i.e., notify system) capable of retrieving service information according to the status and position information about a user from a user database and notifying a service provider of the information.

In the same field of endeavor Toru discloses an application link unit (i.e., notify system)(**drawings 1 and 2**) capable of retrieving service information according to the status and position information about a user from a user database and notifying a service provider of the information (i.e., a technology is described for determining the present location, date, time, and place of a user and conducts an advising process only when the determined result matches a predetermined set of conditions) (**paragraphs 0006 –0010**).

Therefore it would have been obvious at the time the invention was made to modify the system of Takahiro to include an application link unit as taught by Toru to make the steps in the invention more efficient.

Consider **claim 17** and as **applied to claim 16**, Takahiro as modified by Toru clearly discloses the claimed invention wherein said absorbs the difference in the technology of the information terminal and the carrier, and acquires the position information about a user (i.e., via the gateways the service synchronous position information acquisition unit of the system can accept or absorb information from different devices such as notebooks, mobile terminals. the service synchronous position information acquisition unit of the system. via the gateways the service synchronous position information acquisition unit can also absorb the difference in technology from the

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carriers such as the internet or wireless providers)(**paragraph 0013**)

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Shedrick whose telephone number is (571)-272-8621.

The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid Lester can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles Shedrick  
AU 2687  
September 12, 2005

  
RAFAEL PEREZ-GUTIERREZ  
PRIMARY EXAMINER  
9/12/05